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SN. 09/651,654

ATTORNEY DOCKET NO. CANO:013

REMARKS

Claims 1-3, 6-9, 12-15, and 18 remain pending in this application for which applicant seeks reconsideration. For convenience, a clean copy of the pending claims is enclosed. This reply includes no amendment.

Finality Improper

The examiner made the last Office Action final even though the examiner issued a new ground of rejection. Specifically, the examiner rejected all of the pending claims under 35 U.S.C. § 101. The § 101 rejection was made for the very first time. Based on the informal telephonic discussion with the examiner, the § 101 rejection was made not because of the Amendment to the claims made in the last reply, but because of the internal PTO mandate.

Applicant submits that it is improper to finally reject the claims since the examiner made a new ground of rejection that is not based on the previous reply. Applicant therefore urges the examiner to withdraw the finality of the previous Office Action or withdraw the § 101 rejection.

§ 101 Rejection

Claims 1-3, 6-9, 12-15, and 18 stand rejected under 35 U.S.C. § 101 because "the claimed invention is deemed directed to non-statutory subject matter." The examiner merely recites that these claims are not in Technological Arts, since no technology is recited. Applicant traverses this rejection because it is improper at least to the extent that the examiner provides no basis for this rejection.

Indeed, the examiner has blindly rejected all of the claims without analyzing the contents of the claims, essentially attempting to place the onus on applicant to explain why the claims meet the § 101 requirements. The examiner has the burden of establishing a prima facie case that the claimed invention as a whole is directed solely to an abstract idea or to manipulation of abstract ideas, or otherwise does not produce a useful result. The examiner has not met that burden. Note that MPEP § 2106 particularly states that a claim should be rejected under § 101 only when it is devoid of any limitation to a practical application in the technological arts. Here, the examiner merely asserts a circular conclusory reasoning that the pending claims are not in Technological Arts because no technology is recited, even though the claims clearly recite image searching technology. The examiner's simply provides no basis for the rejection.

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Applicant submits that the pending claims are in Technological Arts, and meet the statutory requirement under § 101. The pending claims meet the § 101 requirement as long as the invention set forth in the claims as a whole produces a "useful, concrete, and tangible" result that has a practical application. Independent claim 1 calls for an image search apparatus, independent claim 7 calls for a search method, and independent claim 13 calls for a storage device storing a computer program that all relate to a unique image searching technique. Each of these claims provide useful, concrete, and tangible result that has a practical application, namely outputting images in the order according to the importance of the keyword associated with the images to be searched.

Applicant requests the examiner to withdraw this rejection. Should the examiner maintain this rejection, applicant requests an interview with the examiner in the presence of the examiner's Supervisor before the examiner issues a next action.

#### Art Rejection

Claims 1-3, 6-9, 12-15, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sano (USP 5,038,379) in view of Jones (USP 6,415,302). Applicant traverses this rejection because the combination, even if deemed proper for argument's sake, would not have taught outputting the searched images in the order according to a plurality of levels of importance of the keyword associated with the searched images, as set forth in current independent claims 1, 7, and 13.

Claims 1, 7, and 12 call for storing a keyword table in a memory. The keyword table includes a keyword that corresponds to a plurality of images, and a plurality of levels of importance of the keyword with respect to the plurality of images. The claims further call for searching the images according to an input search query related to the keyword, and acquiring the levels of importance of the keyword based on the images searched are acquired. The claims further call for outputting the searched images in the order according to the levels of importance of the keyword acquired.

Applicant previously explained that Sano does not teach searching images based on the level of importance of the keywords in relation to the content of the image being searched. The examiner now agrees, but asserts that Jones discloses that feature, relying on paragraph 11, lines 52-60. Jones merely discloses displaying a part of a record, based on the level of

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importance, by selecting the next/previous story icon. Specifically, Jones uses next/previous story icons to allow the end user to navigate through stories on a particular page. Selecting the next story icon displays, in clear text format, the story with the next lower level of importance on the same page. This is equivalent to accessing the story corresponding to a RECORD having the same page number but with a story number one greater than the RECORD corresponding to the story currently displayed on the screen. Selecting the previous story icon displays, in a clear text format, the story with the next higher level of importance on the same page. This is equivalent to accessing the story corresponding to the RECORD having the same page number but having a story number one less than the story number of the RECORD corresponding to the story currently being viewed. See column 11, lines 51-60.

Jones essentially discloses selecting the next/previous story icon to display the story with the next lower or higher level of importance on the same page, but not between different pages. Jones discloses only a particular story on one page. That particular story does not exist on any other page. Accordingly, the level of importance of each of the stories does not differ from page to page. Thus, Jones would not have taught searching based on the level of importance of each of stories with respect to a plurality of pages. Accordingly, neither Sano nor Jones would have disclosed or taught outputting images in the order according to a plurality of levels of importance of the keyword associated with a plurality of images, as set forth in current claims 1, 7, and 13.

In sum, the combination, even if deemed proper for argument's sake, would not have taught the outputting feature discussed above. Moreover, the combination would not have taught the storing feature of storing a keyword table that includes a keyword that corresponds to a plurality of images, and a plurality of levels of importance of the keyword with respect to the plurality of images, as set forth in the independent claims.

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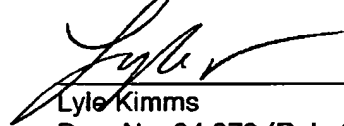
Conclusion

Applicant submits that all of the pending claims patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

ROSSI, KIMMS &amp; McDOWELL LLP

12 April 2005  
Date

  
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Lyle Kimms  
Reg. No. 34,079 (Rule 34)

P.O. BOX 826  
Ashburn, VA 20146-0826  
703-726-6020 (Phone)  
703-726-6024 (fax)